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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,843	12/27/2000	Taira Hanaoka	14196	6311

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 SCULLY SCOTT MURPHY & PRESSER, PC  
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 SUITE 300  
 GARDEN CITY, NY 11530

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,843

Applicant(s)

HANAOKA ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This action is responsive to the paper(s) filed 6/6/05.

#### ***Claim Rejections - 35 USC § 103***

5           The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10           (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

          Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al (418) (US6546418) in view of Dougherty et al (US6587859).

15           Regarding claims 1, 3, 6, Schena et al (418) teaches methods and apparatus for scanning printed codes (such as barcode images) which are processed by an extraction element which decodes an associated URL that is used to retrieve advertising information over a network and display it to the user on the apparatus [abstract, 6:19-21]. Schena et al does not teach displaying the scanned image on the apparatus.

20           Schena et al does teach scanning the codes for immediate or delayed processing or for reference and that *the links may be collected, sorted and prioritized* [10:7-12, 43-47]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the history of scanned links as bookmarks so that a user could recall the collection of stored links for future reference, in a manner as is well known with

25           bookmarking websites. Dougherty et al also teaches scanning physically printed code in a publication whereby scanning the code with an optical scanner directs the user to a

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website for more information [abstract, fig 10, 4:54-67, 5:1-6]. Dougherty et al teaches that the codes may have machine readable content as well as human-readable image content that indicates the destination content and/or destination format. It would have been obvious to one of ordinary skill at the time of the invention to have included the  
5 image content within the machine-scannable code so that the links are more user-friendly and users can determine what content is available at the destination. It would have been obvious to one of ordinary skill at the time of the invention to have displayed such image-embedded "multicon linkmarks" on the display so that Schena et al's suggested collection of stored bookmarks could be identified and selected for future  
10 reference.

Regarding the claim 1 preamble, no limitation is provided in the body of the claim to require "portable"; the language in the preamble is not taken to breathe life into the claim and is not taken as limiting. Nonetheless, the apparatus of Schena et al (418) is taken to be "portable" and capable of being moved.

15 Regarding claims 4, 5, 7, Schena et al (418) teaches the use of a network url to display advertising on a web page [9:1-5]. The printed publication that includes the coding is taken to provide an article. The displayed content may be video [2:30-56].

Regarding claims 8-11, 13, 14, Schena et al (418) teaches that displayed ads are tracked for billing purposes. It would have been obvious to one of ordinary skill at the  
20 time of the invention to have provided an accounting server with charge table (database) to keep track of the billing. Schena et al (418) teaches that the billing may be based on the advertising selected and the number of impressions (access number).

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Official Notice is taken that it is well known to charge for advertising based on other functions such as time of day, the referring article content and the type of ad. It would have been obvious to one of ordinary skill at the time of the invention to have based advertising billing on any of these methods in order to charge the advertiser for the provided ads. Further, Schena et al (418) teaches sharing revenue/fees among all involved parties including bandwidth carrier (ISP provider), advertiser, content provider, etc. It would have been obvious to one of ordinary skill at the time of the invention to have charged the publisher for any portion of any required ISP connection charges so as to reduce/eliminate ISP connections charged for the user – a practice which is well known.

Regarding claim 12, Schena et al (418) teaches that the advertising/content displayed may be tailored to the user according to the user's location [7:15-20].

### ***Response to Arguments***

Applicant argues that impermissible hindsight was used to formulate the rejection and that because Dougherty desires an "intuitive" interface, the reference teaches away from the instant invention. Examiner believes that the combination was proper and further that an image-based bookmarking system for Schena et al's collection of scanned links is actually quite an "intuitive" interface to store, index, manage and select particular links from among the collection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE**  
5 MONTHS from the mailing date of this action. In the event a first reply is filed within  
TWO MONTHS of the mailing date of this final action and the advisory action is not  
mailed until after the end of the **THREE-MONTH** shortened statutory period, then the  
shortened statutory period will expire on the date the advisory action is mailed, and any  
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
10 the advisory action. In no event, however, will the statutory period for reply expire later  
than **SIX MONTHS** from the mailing date of this final action.

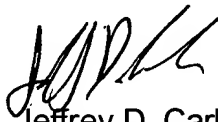
Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-  
15 6716. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate  
Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for  
the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey D. Carlson  
Primary Examiner  
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